

Notice of Allowability

Application No.

09/100,516

Examiner

David H Kruse

Applicant(s)

KASTER ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the Amendment filed 4 December 2003.
 2. ☒ The allowed claim(s) is/are 1,3-7,10,11,22,24 and 25, renumbered 1-3,5-11 and 4.
 3. ☐ The drawings filed on _____ are accepted by the Examiner.
 4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
 5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
 6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**
7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>12/03</u> . |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No. _____ | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8 <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

EXAMINER'S AMENDMENT

1. An extension of time under 37 CFR § 1.136(a) is required in order to make an examiner's amendment, which places this application in condition for allowance. During a telephone conversation conducted on 12 January 2004, Dana Rewoldt requested an extension of time for 2 MONTH(S) and authorized the Director to charge Deposit Account No. 070190 the required fee of \$ 420 for this extension and authorized the following examiner's amendment. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR § 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

Claims 2, 8, 9, 21 and 23 have been cancelled.

Claim 5 and 12-20 are also cancelled.

Claim 1 (Amended) A method of producing transgenic [plant] seed or transgenic progeny [as seeds and optionally as] plants which [shows herbicide] have resistance[,] to [a herbicide comprising] glyphosate, said method comprising:

(i) applying said [herbicide] glyphosate to [at least a portion of] a population of plants, at least some of said plants being heterozygous (Rr) for the glyphosate [, wherein the R is the herbicide resistant [gene] transgene and the r is not evidencing the herbicide resistant] resistance [gene] transgene, [such herbicide application] said applying being at an advanced vegetative state before flowering[;], wherein the [applied herbicide] glyphosate effectively eliminates the [fertilization ability] viability of the male gametes which do not carry the [herbicide] glyphosate resistant gene (R), wherein the [result] surviving male gametes which are capable of fertilizing female [plant parts]

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gametes [are preferentially carrying] carry the [herbicide] glyphosate resistance transgene (R); and

(ii) [obtaining preferentially herbicide] producing glyphosate resistant transgenic seed or transgenic plant progeny from said seed or plant population wherein the plant progeny are [carrying the herbicide resistance gene (RR) or (Rr) therefrom as seeds and optionally as plants] homozygous (RR) or heterozygous (Rr) for the glyphosate resistance transgene.

At claim 6, the phrase "progeny comprise herbicide resistant" has been replaced with -- seed are --.

At claim 7, the phrase "further desired" has been replaced with -- second --.

Claim 10 (Amended) The method according to claim 7 wherein the second transgene [is a fertility/sterility controlling gene] controls fertility.

Claim 11, (Amended) The method according [according] to claim 10 wherein said [fertility/sterility controlling gene is a male sterility gene] second transgene controls male fertility.

At claim 22, the phrase "progeny comprise" has been replaced with -- seed are --

Claim 24 (Amended) A method of producing transgenic hybrid [plant] progeny [as seeds and optionally as] plants which show[s herbicide] resistance[,] to [a herbicide comprising] glyphosate, said method comprising:

(i) applying said [herbicide] glyphosate to [at least a portion of] a population of progenitor plants, at least some of said progenitor plants being heterozygous (Rr) for

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the glyphosate], wherein the R is the herbicide resistant gene and the r is not evidencing the herbicide resistant] resistance transgene, such herbicide application being applied at an advanced vegetative state before flowering[;], wherein the [applied herbicide] glyphosate effectively eliminates the [fertilization ability] viability of the male gametes which do not carry the [herbicide] glyphosate resistant gene (R), [whereby] wherein the [resultant] surviving male gametes which are capable of fertilizing female [plants] gametes [are preferentially carrying] carry the [herbicide] glyphosate [resistant] resistance transgene (R)[;], such that resultant [pollen] male gametes from said plants fertilize inbred female plants which are [selected from a group essentially consisting of inbred female plants which are:] homozygous (RR)[,] or heterozygous (Rr) for the [G]glyphosate [resistant] resistance [gene] transgene; and

(ii) [obtaining preferentially herbicide] producing glyphosate resistant transgenic hybrid seed or transgenic plant progeny from said inbred female plants wherein the seed or plant progeny[, as seeds and optionally as plants,] are [carrying the herbicide resistance gene (RR) or (Rr) therefrom] homozygous (RR) or heterozygous (Rr) for the glyphosate transgene.

Claim 25 (new) The method according to claim 4 wherein in step (i), the herbicide is applied at the V5 stage of growth or later.

The Abstract, on page 16 of the specification, has been replaced with the following:

-- The invention relates to a method of breeding plants that are glyphosate resistant due to a transgene whereby all of the resulting progeny plants or seed are also

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glyphosate resistant due to inheritance of the transgene by elimination of male gametes that do not carry a resistance transgene. --

The Title of the invention has been replaced with:

-- A METHOD OF BREEDING GLYPHOSATE RESISTANT PLANTS --

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (703) 306-4539, **(571) 272-0799 after 6 January 2004**. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Amy Nelson can be reached at (703) 306-3218, **(571) 272-0804 after 6 January 2004**. The fax telephone number for this Group is (703) 872-9306 Before Final or (703) 872-9307 After Final.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-0196.

David H. Kruse, Ph.D.
30 December 2003



AMY J. NELSON, PH.D.
SUPERVISORY PATENT EXAMINER
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